

MAR 21 2005

Docket No.: 041-1903A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Divisional Application of :

Takeo OHISHI et al. :

Serial No. 09/434,161 : Group Art Unit: 2616

Filed: 11/04/1999 : Examiner: BOCCIO VINCENT F

For: **PACKET DATA RECORDING/REPRODUCING APPARATUS****PETITION UNDER 37 CFR 1.181 to INVOKE THE SUPERVISORY AUTHORITY OF
THE DIRECTOR AND WITHDRAW PREMATURE FINAL ACTION****MAIL STOP AF**Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Official Action mailed October 20, 2004, the time for response to which is extended by an accompanying Petition and Fee to March 20, 2005 (a Sunday and hence to Monday, March 21, 2005), applicants submit that the pending official action has been prematurely designated a "Final" action and respectfully petition the Director to exercise his supervisory authority to withdraw finality of the Official Action.

STATEMENT OF THE FACTS INVOLVED

In response to a final action mailed June 15, 2003, on September 15, 2004, applicants filed a Request for Continued Examination (RCE) along with a submission amending the claims.

The claim amendments included:

- 1) added limitations in the pending method claims 3, 4 and 20-22, and

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2) new apparatus claims 45, 46 and 47.

In response, in the Action dated October 20, 2004 undertook a detailed analysis of the limitations added to the claims and of applicants' disclosure, asserted (at page 4, lines 1-3) an agreement with applicants' assertion that confusion exists between PCRs and time stamps but concluded therein that "the amendment does not clarify and does not distinguish, time stamps from the PCRs."

For the first time, the Examiner states (page 4, lines 7-9) that the rejection over the prior art (Van Gestel reference) is "based on applicant's disclosures in combination with the examiner's knowledge".

The action also rejects the newly submitted claims 45 and 47 under 35 USC 102(e) over the same art applied to claims 20 and 22.

Finally, the action concludes that "all claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application" and makes the action FINAL.

POINTS TO BE REVIEWED

Applicants respectfully request review and reconsideration of the Examiner's assertion that "all claims are drawn to the same invention claimed in the earlier application", and the action taken October 20, 2004 making the action final.

ARGUMENT

The Manual of Patent Examining Procedure (MPEP) provides at §706.07(b) that a first Office action may be made final if the rejected claims meet TWO requirements.

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More particularly, the Manual states that such a final rejection may be made if "all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application."

Applicants respectfully submit that the present situation fails to meet the requirements of at least one of the requirements of MPEP §706.07(b) and, accordingly, that final rejection of the same is premature.

It is more specifically submitted that the amended claims presented in the amendment filed September 15, 2004, were not the same as, or "drawn to the same invention claimed in the earlier application" and thus that a first action rejection of the same can not be made final prematurely.

Determination of whether claims in an application are drawn to the same invention as another application may be appreciated from an analogous consideration provided in the MPEP. Although the present situation does not relate to double patenting, the analysis provided in the wording of MPEP §804 II(a) with respect to applying a statutory double patenting rejection or a judicially created obviousness-type double patenting rejection is instructive.

MPEP §804 II(b) notes that "'Same invention' means identical subject matter", citing *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1984); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957).

Clearly, where claims recite different limitations the subject matter is not identical.

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Indeed, the MPEP continues that “[i]f there is ... an embodiment [that falls within the scope of one claim, but not the other], then identical subject matter is not defined by both claims and statutory double patenting would not exist” -- i.e., the two claims are not for “the same invention”.

Therefore, as the amendment of claims 3-4 and 20-22 provided claims having different limitations than the previously pending claims, it is possible to conjure an embodiment that falls within the scope of the original claims but not within the scope of the amended claims. Therefore, the amended claims are not for the same invention as the previously pending claims.

Still further, it is quite clear that the amendment filed September 15, 2004 introduced new claims which are of a different statutory class than the original claims.

While claims 3-4 and 20-22 are method claims, claims 45-47 are apparatus claims.

Again, it is quite possible to conjure an embodiment that falls within the scope of the method claims but not within the scope of the apparatus claims, and vice versa. Therefore, newly introduced claims 45 and 47 are not for “the same invention” as the previously pending claims.

The Examiner may have intended to assert that subject matter of the amended and newly submitted claims would have been *obvious* over the subject matter of the original claims, in reliance on applicants’ disclosure and could have been rejected under the same grounds. However, whether or not this assertion has merit, it is clear that the present claims are not for the “same invention” as presented in the prior claims.

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Moreover, in response to the amendment of September 15, 2004 it was necessary for the examiner throughout pages 2-4 of the action to rely for the first time on various portions of applicants' specification. This fact is believed to demonstrate that, not only is the first requirement ("same invention") of MPEP §706.07(b) not met by the present circumstances, but that the second requirement ("same grounds") similarly is not met as the Examiner now identifies reliance on applicants' disclosure along with his own (unidentified) personal knowledge (page 4, paragraph 3).

In any case, however, the need to refer to applicants' disclosure following addition of a limitation to the claims demonstrates that the claims are not to the "same invention".

Therefore, inasmuch as the claims pending after submission and acceptance of an RCE are not for the same invention as previously recited, it is respectfully submitted that the requirements of MPEP §706.07(b) have not been met and that a first rejection of such claims cannot be made final.

ACTION REQUESTED

In view of the foregoing, applicants request that the pending official action be withdrawn and that a proper, NON-FINAL action be issued instead.

Respectfully submitted,
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